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7/26/01

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pliant Technologies, Inc.

Serial No. 75/739,014

Fred G. Pruner, Jr. for Pliant Technologies, Inc.

Wendy E. Goodman, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Seeherman and Hanak, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Pliant Technologies, Inc. (applicant) seeks to register ELF in typed drawing form for a "house mark for a complete line of computer programs that use a non-hierarchical structure for the organization, storage, integration and retrieval and exchange of data, information and applications." The intent-to-use application was filed on June 30, 1999.

Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark ELF, as applied to applicant's goods, is likely to cause confusion with the identical mark ELF,

previously registered in typed drawing form for "computer programs and

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instructional manuals sold as a unit for spreadsheet and graphics-based statistical data entry, manipulation and analysis." Registration No. 1,368,757.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.")

Considering first the marks, they are identical. Thus, the first Dupont "factor weighs heavily against applicant" because the two word marks are identical. In re Martin's Famous Pastry Shoppe Inc., 748 F.2d 1565, 223

USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of applicant's goods and registrant's goods, we note that because the marks are identical, their contemporaneous use can lead to the

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assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

However, in this case we find that applicant's goods as described in its application and registrant's goods as described in its registration are clearly related. The foregoing underlined words are critical because our primary reviewing Court has made it abundantly clear that "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in [registrant's] registration, rather than what the evidence shows the goods and/or services to be."

Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). _

Applicant seeks to register ELF as a "house mark for a complete line of computer programs that use a non-hierarchical structure for the organization, storage, integration, retrieval and exchange of data, information and applications." (emphasis added). Registrant's ELF

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registration is for "computer programs and instructional manuals sold as a unit for spreadsheet and graphics-based statistical data entry, manipulation and analysis." (emphasis added). The term "data entry program" is defined as "an application program that accepts data ... and stores it in the computer." The Computer Glossary (9th ed. 2001)(emphasis added). Thus, applicant's complete line of computer programs for the storage of data is clearly related to registrant's computer programs for data entry. Indeed, but for differences in terminology, it appears that applicant's complete line of computer programs as described in the application and registrant's computer programs as described in the registration are, in part, essentially the same.

In arguing that its goods are different from registrant's goods, applicant disregards the teachings of

Canadian Imperial Bank and instead focuses on the purported differences in applicant's actual goods and registrant's actual goods. In this regard, applicant attached to a paper dated May 10, 2000 what purports to be registrant's web page describing registrant's ELF computer programs. Based upon this visit to registrant's web page, applicant argues that

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its actual computer programs and registrant's actual computer programs are different. For example, at pages 2 and 3 of its brief, applicant argues that its computer programs are of a non-hierarchical structure, whereas registrant's computer programs employ a hierarchical structure. There are two problems with applicant's argument. First, applicant has made of record no evidence showing that registrant's actual computer programs are limited to those using a hierarchical structure as opposed to a non-hierarchical structure. Second, and of even greater importance, is the fact that even if applicant had made of record such evidence, this evidence pertaining to registrant's actual goods would be of no consequence because pursuant to Canadian Imperial

Bank, this Board must consider registrant's goods as described in the registration. Registrant's description of its goods is broad enough to include both computer programs of a hierarchical and non-hierarchical nature.

One final comment is in order. At page 3 of its brief applicant argues that the purchasers of its actual computer programs are sophisticated and exercise a high degree of care in purchasing applicant's actual computer programs

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because (1) applicant's actual computer programs are expensive, and because (2) applicant's actual computer programs are "critical to the success of the purchaser's web site." Again, applicant's argument suffers from two defects. First, applicant has made of record no evidence demonstrating that its purchasers are sophisticated; that its computer programs are expensive or that its computer programs are critical to the success of the purchaser's web site. However, even if opposer had made of record evidence demonstrating the foregoing features of its actual computer programs, applicant's own chosen description of goods is far broader than what applicant

contends that its actual goods are. Again, it must be remembered that applicant seeks to register the identical mark ELF for a "house mark for a complete line of computer programs that use a non-hierarchical structure for the organization, storage, integration retrieval and exchange of data, information and applications."

(emphasis added). The words "complete line of computer programs" clearly indicate that applicant is seeking to gain registration rights in its mark ELF for a very broad range of computer programs.

In summary, based upon the fact that applicant seeks to

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register the identical mark ELF for computer programs which, at least in part, overlap registrant's computer programs as described in the cited registration, we find that there exists a likelihood of confusion resulting from the contemporaneous use of the identical mark ELF by applicant and registrant.

Decision: The refusal to register is affirmed.

